

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSUMU KADOKURA, NOAKI SHIRAI,
SHIGERU YOSHIMURA, TOMOAKI KATO,
YOSHIAKI TOMARI and TADANORI SUTO

Appeal No. 1997-0424
Application 07/985,253¹

HEARD: NOVEMBER 4, 1999

Before JERRY SMITH, LALL and GROSS, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection² of claims 1 to

¹ Application for patent filed December 3, 1992.

² An amendment after the final rejection was filed on Aug. 8, 1995, however, it made no changes to the claims. Also, the

5 and 7 to 13.

The disclosed invention relates to a delivery member for delivering an image receiving medium such as recording paper to an image forming station. The invention is further directed to an electrophotographic apparatus and an inkjet recording apparatus, each employing such a delivery member. The invention provides for a delivery member which maintains a uniform surface and consistent coefficient of friction even after the delivery of thousands of sheets of paper. The invention is further illustrated by the following claim.

Representative claim 1 is reproduced as follows:

1. A delivery member comprising a substrate material, a first coating film comprising a resin containing a filler and formed by electrodeposition on the substrate material, and a second coating film composed of an organic coating film formed on the first coating film.

The references relied on by the examiner are:

Takahashi	4,541,711	Sep. 17, 1985
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"index of claims" indicates that claim 7 was objected to, but the final rejection, the answer and the brief all indicate that claim 6 was objected to. Thus, claims 1 to 5 and 7 to 13 are before us on appeal.

Appeal No. 1997-0424
Application 07/985,253

Masubuchi et al. (Masubuchi) 4,888,244 Dec. 19,
1989

Claims 1 to 5 and 7 to 13 stand rejected under 35 U.S.C.
§ 103 over Takahashi and Masubuchi.

Reference is made to Appellants' briefs³ and the
Examiner's answer for their respective positions.

OPINION

We have considered the record before us, and we will
reverse the rejection of claims 1 to 5 and 7 to 13.

With respect to claims 1 to 5 and 7 to 13, the Examiner
has failed to set forth a prima facie case of obviousness. It
is the burden of the Examiner to establish why one having
ordinary skill in the art would have been led to the claimed
invention by the express teachings or suggestions found in the
art, or by implications contained in such teachings or
suggestions. In re Sernaker, 702 F.2d 989, 995, 217 USPQ 1, 6
(Fed. Cir. 1983). "Additionally, when determining
obviousness, the claimed invention should be considered as a

³A reply brief was filed on Oct. 1, 1996 and was entered
in the record on Oct. 31, 1996 without any response by the
Examiner.

whole; there is no legally recognizable 'heart' of the invention." Para-Ordnance Mfg. v. SGS Importer Int'l, Inc., 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 117 S.Ct. 80 (1996) citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

All the independent claims, 1, 8 and 13, and hence the dependent claims, 2 to 5, 17 and 9 to 12, contain the limitation that the delivery member comprises a substrate material, a first coating film comprising a resin containing a filler and formed by electrodeposition on the substrate material, and a second coating film composed of an organic coating film formed on the first coating film. The Examiner combines Takahashi with Masubuchi within the meaning of 35 U.S.C. § 103. Thus, the Examiner asserts that "It would have been obvious ... to apply the coating of Masubuchi et al. to the delivery member of Takahashi to protect the member from unwanted chipping and corrosion from constant contact, as Masubuchi et al. discussed." [Answer, page 4].

While the Examiner is correct in finding that Masubuchi teaches the application of two coatings on a substrate to

protect the substrate against chipping and corrosion, a common problem with the paint on the automobiles and electrical appliances with which Masubuchi is concerned, the Examiner is off the mark in deducing that Masubuchi solves the problem Appellants are dealing with, which is to protect the delivery member against abrasion. We find nothing in Masubuchi, and neither does the Examiner, which discusses abrasion and/or friction between contacting surfaces.

Therefore, we agree with Appellants that there is no motivation to combine the teachings of Masubuchi with Takahashi [brief, pages 8 to 17 and reply brief, pages 1 to 3]. The Federal Circuit states that "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fitch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d at 1087, 37 USPQ 2d at 1239 (Fed.

Appeal No. 1997-0424
Application 07/985,253

1995), citing W. L. Gore & Assocs., v. Garlock, Inc., 721 F.2d at 1553, 220 USPQ at 312-13 (Fed. Cir. 1983).

Therefore, we conclude that the suggested combination of Takahashi and Masubuchi is improper and the Examiner has not established a prima facie case of obviousness to reject the independent claims 1, 8 and 13 and, hence, the dependent claims 2 to 5, 7 and 9 to 12 within the meaning of 35 U.S.C. § 103.

DECISION

The decision of the Examiner rejecting claims 1 through 5 and 7 through 13 under 35 U.S.C. § 103 over Takahashi and Masubuchi is reversed.

REVERSED

JERRY SMITH

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Appeal No. 1997-0424
Application 07/985,253

Administrative Patent Judge)	
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PARSHOTAM S. LALL)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

Appeal No. 1997-0424
Application 07/985,253

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